

Application No. 10/719,394

Remarks

The final Office Action of December 21, 2005, has been carefully considered. This amendment is believed to place the application in condition for allowance, or at least to materially reduce and simplify the issues for appeal. Entry of this proposed amendment is, therefore, respectfully requested.

Claims 1-3, 8-13, and 18-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Titterington et al. (5,372,852) in view of Kessler (4,458,399).

Claims 4-7 and 14-17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Titterington et al. in view of Kessler as applied to claim 1. Initially, the Applicants must point out that none of the applied prior art addresses the problems or its solution in which the present invention is directed to. The present invention is directed to the problem of supplying release liquid in ink jet printing systems that utilize intermediate transfer ink jet recording methods; in particular to an applicator assembly that has improved distributing properties and longer life. As discussed, on page 2 of the specification "Existing applicator assembly and oiling methods employ an impregnated foam or capillary media roll that is brought into contact with the image drum forming a nip and thereby displacing oil from the pores to the drum. It is then wiped to a consistent level using a urethane blade. The existing method results in oil levels that are too high for some applications. The high oil levels result in a variety of issues such as offset, reduced gloss, expense, reduced foam roll life etc. In response to this issue, applicants have explored using traditional RAM's to meter oil onto the image drum. Applicants have found that this method is prone to contamination (due to the solubility of the ink with silicone oil) and is an expensive design in comparison

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to a foam roll system. The present invention obviates the problems noted above by utilizing a system in which a porous oil donor roll is loaded to a low saturation level and the fluid level is controlled by monitoring the mass of the roll and refilling when the mass drops below a predetermined level." The prior art applied does not address this problem nor its solution.

The disclosures of the cited art and the distinctions between claims may be briefly summarized as follows:

Titterington et al. teaches a phase change ink composition is indirectly applied to a substrate by raising the temperature of the phase change ink composition to form a liquid phase change ink composition, applying droplets of the phase change ink composition in a liquid phase to a liquid intermediate transfer surface on a solid support in a pattern using a device such as an ink jet printhead, solidifying the phase change ink composition on the liquid intermediate transfer surface, transferring the phase change ink composition from the liquid intermediate transfer surface to the substrate, and fixing the phase change ink composition to the substrate. The phase change ink composition is malleable when the ink is transferred from the intermediate transfer surface to the substrate and is ductile after the ink has been transferred to the substrate and cooled to ambient temperature to preclude the ink from crumbling and cracking. Titterington et al. fails to teach that said applicator assembly including a porous member having a core, said core having openings defined therein, a liquid supply system connected to said core for supplying release liquid to saturate said porous member.

The Examiner has cited and suggested a combination of Titterington et al., with the isolated teachings of Kessler directed to a device for supply "ink" to a hand-held portable labeler; and with Takahashi et al directed to a device for supply "ink" to a stencil duplicator.

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However, it is respectfully submitted that there is not a proper factual or legal basis for any suggestion for that combination, and that combination does not teach the invention.

Kessler and Takahashi et al. both fail to teach said applicator assembly including a porous member having a core, said core having openings defined therein, a liquid supply system connected to said core for supplying release liquid to saturate said porous member to a low saturation level, combination of Titterington et al. Kessler and Takahashi et al. do not teach the claimed structure or system, and also does not provide the suggestion to combine required by the controlling case law and the MPEP.

See, in particular, MPEP §706.02(j) and controlling Federal Circuit caselaw such as *Yamanouchi Pharmaceutical Co. v. Danbury Pharmacal Inc.*, 231 F.3d 1339, 56 USPQ2d 1641 at 1644 (Fed. Cir. 2000), *Ecolchem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000), and *McGinley v. Franklin Sports Inc.*, 60 USPQ2d 1001, at 1008 (Fed. Cir. 8/21/01). As stated by the Court in that decision:

"The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some 'teaching, suggestion or reason' to combine cited references. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997). When the art in question is relatively simple, as is the case here, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. See *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), *limited on other grounds by In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769 (2000) (guarding against falling victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher)."

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The following current MPEP Sections on §103 rejections are controlling here: MPEP §2141, §§2144 - 2144.09 and §706.02(j).

Under MPEP §706.02(j), a rejection based on 35 USC §103 is authorized "where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references."

According to MPEP §2141, when applying 35 USC §103, the Examiner must adhere to the basic tenets of patent law:

- A. The claimed invention must be considered as a whole;
- B. The references must be considered as a whole and must suggest the desirability of making the combination;
- C. The references must be viewed without the benefit of impermissible hindsight afforded by the claimed invention; and
- D. Obviousness must be determined under a reasonable expectation of success standard.

Furthermore, in order to establish a *prima facie* case of obviousness, patent Examiners are required to establish three criteria:

- (1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- (2) There must be a reasonable expectation of success; and
- (3) The prior art reference, or combination or references, must teach or suggest all the claim limitations.

The MPEP also notes that the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.

The litany of CAFC decisions requiring a specific suggestion to combine references is further exemplified in *In re Lee*, 277 F.3d 1338, 61 USPQ2d at 1430, (Fed. Cir. 1/18/02). It reiterates that: "...a showing of a suggestion, teaching, or motivation to combine the prior art references is an

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'essential component of an obviousness holding," quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ('Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.');

In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ('teachings of references can be combined only if there is some suggestion or incentive to do so.') (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ('particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed').

In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the Examiner can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references)."

Since this amendment materially reduces the issues raised by the Examiner and is not directed to differently claimed subject matter, which would require a further search by the Examiner, it should be entered inasmuch as it places the application either in condition of allowance, or, in better condition for appeal.

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No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation attorney (or agent) hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby directed to call Lloyd F. Bean, II, at Telephone Number 585-423-4520, Rochester, New York.

Respectfully submitted,



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